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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
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ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,981	WATERS ET AL.	
	Examiner	Art Unit	
	Dilek B. Cobanoglu	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-21 have been examined.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

4. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,393,404,B2 in view of Little et al. (U. S. Patent No. 5,359,509) and Iliff (U.S. Patent No.5,724,968).

It appears that the only difference between this application and U.S. Patent No. 6,393,404,B2 is that the claims of this application disclose "listing alphanumeric codes for a plurality of medical procedures", and the claims of the reference patent do not cover alphanumeric codes. But the abstract and the body of the reference patent disclose "alphanumeric codes for a plurality of medical procedures" (see abstract and col. 2, lines 40-54). Therefore claims 1-21 are rejected on the ground of non-statutory obviousness-type double patenting.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 and 7-21 are rejected under 35 U.S.C. 102(b) as being unpatentable by Little et al. (U. S. Patent No. 5,359,509).

A. As per claim 1, Little et al. discloses a method of optimizing medical diagnosis, procedures and reimbursement claims using a structured search space, the method comprising:

i. listing alphanumeric codes that represent each of a plurality of medical procedures to produce a master procedure list, wherein the master procedure list includes simple procedures and compound procedures which consist of at least two simple procedures (Little et al.; col. 7, lines 10-26, col. 9, lines 40-52 and Fig. 7);

ii. associating a value to each of the plurality of medical procedures (Little et al.; col. 7, lines 10-26);

iii. listing medical procedures for a specific medical encounter to produce a list of ordered procedures (Little et al.; col. 6, lines 9-27 and Fig. 2a and 2b);

iv. building a search tree of all possible combinations of the simple procedures and the compound procedures in the list of ordered procedures (Little et al.; col. 7, lines 10-26; and col.8, lines 50-59)

v. searching the search tree for the lowest total of values associated with the medical procedures in the list of ordered procedures (Little et al.; col. 10, lines 41-55 and Fig. 13).

B. As per claim 2, Little et al. discloses the method of claim 1, wherein the master procedure list also includes a short description of the represented medical procedure; a long description of the represented medical procedure, and a list of

all simple procedure that make up all compound procedures (Little et al.; col. 10, lines 41-55).

C. As per claim 3, Little et al. discloses the method of claim 1, wherein the value associated with each of the plurality of medical procedures includes regional costs and fluctuations (Little et al.; col. 10, lines 41-55).

D. As per claim 4, Little et al. discloses the method of claim 1, wherein building a search tree includes:

i. matching compound procedures in the master procedure list to a plurality of simple procedures in the list of ordered procedure to produce a matched compound procedure (Little et al.; col. 7, lines 10-26 and col. 8, lines 50-59);

ii. eliminating the plurality of simple procedures from the ordered procedure list (Little et al.; col. 14, lines 32-41); and

iii. adding the matched compound procedure to the ordered procedure list (Little et al.; col. 14, lines 32-41).

E. As per claim 5, Little et al. discloses the method of claim 1, wherein the method further includes eliminating duplicates of simple procedures in the list of ordered procedures (Little et al.; col. 8, lines 50-59).

F. As per claim 7, Little et al. discloses the method of claim 1, wherein the method is implemented on a general purpose computer (Little et al.; col. 5, lines 18-24).

G. As per claim 8, Little et al. discloses the method of claim 1, wherein the listing of the medical procedures is implemented by a medical professional at the medical encounter (Little et al.; abstract and col. 4, lines 26-43).

H. As per claims 9-16, they are article of manufacture claims, which repeat the same limitations of claims 1-8, the corresponding method claims, as a computer program which instructs a series of process steps. Since the combination of teachings of Little et al. and Iliff disclose the underlying process steps that constitute the method of claims 1-8, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claims 9-16 are rejected for the same reasons given above for claims 1-8.

I. As per claims 17-21, they are system claims, which repeat the same limitations of claims 1-3 and 6-7, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the combination of teachings of Little et al. and Iliff disclose the underlying process steps that constitute the methods of claims 1-3 and 6-7, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 17-21 are rejected for the same reasons given above for claims 1-3 and 6-7.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Little et al. (U. S. Patent No. 5,359,509) in view of Iliff (U.S. Patent No.5,724,968).

A. As per claim 6, Little et al. discloses the method of claim 1.

Little et al. fails to expressly teach a palm sized computer, per se, since it appears that Little et al. is more directed to plurality of minicomputer or microcomputer workstations (Little et al.; col. 5, lines 25-28). However, this feature is well known in the art, as evidenced by Iliff

In particular, Iliff discloses a system and method for providing computerized, knowledge-based medical diagnostic and treatment advice wherein the method is implemented on a palm sized computer (Iliff; abstract and col. 63, lines 62-66).

Examiner considers that it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the plurality of minicomputer or microcomputer workstations with the palm sized computer with the motivation of portability of the handheld or palm computers.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Medical network

management system and process" 5,471,382 A, "Computerized medical diagnostic and treatment advice system" 5,660,176 A, "System and method of context vector generation and retrieval" 5,619,709 A, "Computerized medical advice system and method including meta function" 5,711,297 A, "Medical network management system and process" 5,764,923 A, "Method and apparatus for graphical user interface-based and variable result healthcare plan" 5,786,816 A.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DBC
Art Unit 3626
04/21/2006

C. LUKE GILLIGAN
PATENT EXAMINER